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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,418	11/04/2003	Amnon Shiloni	43098-0009 (188088)	5808
23973	7590	06/01/2004	EXAMINER	
DRINKER BIDDLE & REATH ONE LOGAN SQUARE 18TH AND CHERRY STREETS PHILADELPHIA, PA 19103-6996			JOHNSON, STEPHEN	
			ART UNIT	PAPER NUMBER
			3641	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/700,418

Applicant(s)

SHILONI, AMNON

Examiner

Stephen M. Johnson

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3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 is/are allowed.
- 6) ☒ Claim(s) 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>filed 11/5/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-21, drawn to a handguard including first and second grip halves and a cover, classified in class 42, subclass 143.
  - II. Claims 22-24, drawn to a handguard including a particular mounting apparatus, classified in class 42, subclass 96.
  - III. Claims 25-26, drawn to a rail cover including post engaging members, classified in class 42, subclass 124.
2. The inventions are distinct, each from the other because:
3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I could be used with a different type of mounting apparatus or absent a mounting apparatus and invention II could be used absent a cover (see claim 22). See MPEP § 806.05(d).
4. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I could be used absent a post engaging member and invention III could be used with a handguard that does not contain first and second mating halves. See MPEP § 806.05(d).
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete **must include an election of the invention to be examined** even though the requirement be traversed (37 CFR 1.143).

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the gas return tube; rifle barrel; receiver; and the front-sight/gas return tube assembly must be shown or the feature(s) canceled from the claim(s). **No new matter should be entered.**

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. Claims 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 22, line 1, use of the phrase "of the type" extends the scope of the claim language such that the meets and bounds of the claim are indefinite. How similar to a handguard must a device be to infringe the claims?

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spinner in view of Faifer (321 B2).

Spinner discloses a cover in combination with a handgun mounting rail comprising:

- a) a rail having two rows of opposing posts and a guide channel; 3, 5, 7, 9
- b) a body; 11
- c) a generally flat top portion with outwardly extending sides; 11 (fig. 8)
- d) lips; and 17, 19
- e) post engaging members. 2, 21

Spinner applies as recited above. However, undisclosed is a body that is composed of flexible rubber. Faifer (321 B2) teaches a body that is composed of flexible rubber 20. Applicant is substituting one material type of cover for another in an analogous art setting as explicitly encouraged by both references (see col. 7, lines 57-65 of Spinner and/or col. 4, lines 47-61 of Faifer 321 B2). It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Faifer (321 B2) to the Spinner cover and mounting rail combination and have a cover body made of a different material type.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Sweeney.

Sweeney discloses a handguard mounting apparatus comprising:

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- |  |                                  |
|--|----------------------------------|
| a) a ring of generally hexagonal shape; and  | see periphery of 23 (figs. 5, 7) |
| b) a series of semi-arcuate engagement tabs. | 83, 84                           |

13. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sweeney in view of Bredbury et al..

Sweeney applies as previously recited. However, undisclosed are 6 peripheral engagement tabs. Bredbury et al. teach 6 peripheral engagement tabs 52, 54, 56. Applicant is substituting one number of engagement tabs for another in an analogous art setting. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Bredbury et al. to the Sweeney handguard mounting apparatus and have a mounting apparatus with a different number of engagement tabs.

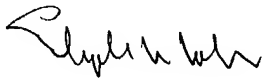
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stoner discloses another state of the art handguard assembly.

15. Claims 1-21 are allowed.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Johnson whose telephone number is 703-306-4158. The examiner can normally be reached on Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703-306-4198. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4177.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326. The fax phone number for after final communications is (703) 872-9327.



STEPHEN M. JOHNSON  
PRIMARY EXAMINER

Stephen M. Johnson  
Primary Examiner  
Art Unit 3641

SMJ